

### **REMARKS**

Reconsideration of this Application is respectfully requested. Upon entry of the amendments, Claims 1, 6-8, 11, 13, 15-17, 20 and 22 are pending. Claims 1, 6, 11, 13, 15, 17, 20 and 22 have been amended. Claims 2-5, 9-10, 12, 14, 18-19, 21 and 23 have been canceled without prejudice or disclaimer. Applicants reserve the right to pursue the subject matter of these claims in one or more divisional or continuation application. No new matter is added.

In the Office Action of March 24, 2005, the Examiner set forth a number of grounds for rejection. These grounds are addressed individually and in detail below.

#### **Claim Amendments**

The Examiner has acknowledged that Claims 3, 6-8, 11, 13, 15, 16 and 18 are free of the prior art. As presently amended, Claim 1 incorporates the limitations of Claims 2 and 3 and Claim 17 incorporates the limitation of Claim 18. Claims 2-5, 9-10, 12, 14, 18-19, 21 and 23 have been canceled. Thus, by virtue of the amendments herein, it is respectfully submitted that all of the presently pending claims are free of the prior art.

#### **Rejections under 35 U.S.C. § 102(b)**

Claims 1-2, 4-5, 9, 12, 14, 17, 19 and 23 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Gao et al., (Hum Gene Ther. 2000 Jan 1;11(1):213-9).

It is respectfully submitted that the basis for the rejection has been rendered moot with respect to Claims 2, 4-5, 9, 12, 14, 19 and 23, which have been canceled herein, and by the amendment of Claims 1 and 17 herein. As presently amended, Claim 1 incorporates the limitations of Claims 2 and 3 and Claim 17 incorporates the limitation of Claim 18, which have been deemed free of the prior art. Since Gao et al., does not

disclose each and every element of the pending claims, the rejection should be withdrawn.

Claims 1-2, 4-5, 9, 10, 12, 14, 17, 19 and 23 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Imler et al., (US 2001/0049136).

It is respectfully submitted that the basis for the rejection has been rendered moot with respect to Claims 2, 4-5, 9, 10, 12, 14, 19 and 23, which have been canceled herein, and by the amendment of Claims 1 and 17 herein. As presently amended, Claim 1 incorporates the limitations of Claims 2 and 3 and Claim 17 incorporates the limitation of Claim 18, which have been deemed free of the prior art. Since Imler et al., does not disclose each and every element of the pending claims, the rejection should be withdrawn.

**Double Patenting**

Claims 1-23 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-23 of co-pending Application No. 10/857,137.

Applicant will address this provisional rejection when the claimed subject matter is allowed and will accordingly amend or cancel claims directed to the same invention in the instant or co-pending application.

**Rejections under 35 U.S.C. § 112, second paragraph**

Claims 20-22 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The Examiner has rejected Claims 20-22 as allegedly being indefinite because there is no antecedent basis for the terms "said E1A expression vector" or "said E1B expression vector" or "said E1A and E1B expression vectors".

It is respectfully submitted that the basis for the rejection has been rendered moot with respect to Claim 21, which has been canceled herein, and by the amendment of

Claims 20 and 22, which no longer refer to the terms "said E1A expression vector" or "said E1B expression vector" or "said E1A and E1B expression vectors". Thus, the rejection should be withdrawn.

**Claim Objections**

Claims 18-19 have been objected to under 37 C.F.R. § 1.75(c) as allegedly being of improper dependent form for failing to further limit the subject matter of previous Claim 17.

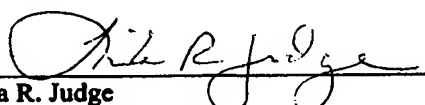
It is respectfully submitted that the basis for the rejection has been rendered moot with respect to Claims 18 and 19, which have been canceled herein, and by the amendment of Claim 17. Amended Claim 17 is directed to method of producing an adenovirus packaging cell line permissive for replication of an E1A/E1B deficient adenovirus vector, by: introducing into a cell line permissive for adenovirus replication, nucleic acid comprising (i) an adenovirus E1A coding sequence operably linked to a promoter that lacks substantial sequence identity with a native adenovirus E1A or E1B promoter and (ii) an adenovirus E1B coding sequence operably linked to a promoter that lacks substantial sequence identity with a native adenovirus E1A or E1B promoter. Amended Claim 17 also incorporates the limitation of Claim 18 wherein the nucleic acid comprising the adenovirus E1A coding sequence and the nucleic acid comprising the adenovirus E1B coding sequence are present on separate vectors. Thus, the objection should be withdrawn.

**CONCLUSION**

In light of the above, Applicants submit that this application is now in condition for allowance and therefore request favorable consideration. If any issues remain which the Examiner feels may be best resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact Applicants' counsel, Linda R. Judge at (415) 836-2586.

Respectfully submitted,

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